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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,734	01/20/2004	Lior Gepstein	27395	7379

7590  
Martin D. Moynihan  
PRTSI, Inc.  
P. O. Box 16446  
Arlington, VA 22215

03/20/2008

EXAMINER
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SINGH, ANOOP KUMAR

ART UNIT	PAPER NUMBER
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1632

MAIL DATE	DELIVERY MODE
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03/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/759,734

Applicant(s)

GEPSTEIN ET AL.

Examiner

Anoop Singh

Art Unit

1632

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 05 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☒ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 176-181 and 196-199.  
Claim(s) withdrawn from consideration: 1-175 and 182-186.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/Peter Paras, Jr./  
Supervisory Patent Examiner, Art Unit 1632

Continuation of 3. NOTE: The proposed amendment to claims 176 and 199 raise new issues that require further search and consideration. Applicant has amended claims 176 and 199 to include new limitation "embryoid bodies comprising a plurality of "non cystic embryoid bodies" exhibiting cardiac phenotype that was not required in previously rejected claims. In addition, proposed amendments will also require new search and additional consideration for new matter. The newly added limitation of human EB comprising a plurality of non-cystic EB constitute new matter. The proposed amendments with new limitations changes the breadth of claims 176 and 199 and therefore proposed amendments to the claims require new search and further consideration for art and new matter purposes

Continuation of 11. does NOT place the application in condition for allowance because: The Examiner maintains the rejection of claims 176-181 and 196-199 for the reasons of record. Applicant arguments filed on 3/5/2008 have been fully considered but they are not fully persuasive. Applicants rebut the rejection of the claims under 35 USC 102(a), 35 USC 102(b), 35 USC 102(e) and 35 USC 103(a) in the reply filed 3/05/2008. Applicant arguments filed on 3/5/2008 have been fully considered but they are not fully persuasive. Applicants arguments based on the proposed amendments are not persuasive, because the claim amendments have not been entered as they require new consideration and search.

Claims 176-177, 196-198 and 199 stand also rejected under 35 U.S.C. 102(b) as being anticipated by Itskovitz-Eldor et al (Mol Med. 2000 Feb;6(2):88-95, IDS) for the reasons of record.

Claims 176-181, 196-199 remain rejected under 35 U.S.C. 102(a) as being anticipated by Itskovitz-Eldor et al (WO 00/70021, published 11/23/2000 ) for the reasons of record.

Claims 176-181, 196-199 stand rejected under 35 U.S.C. 102(e) as being anticipated by Benvenisty (US Patent 7045353, dated 5/16/2006, effective filing date 8/1/2000) for the reasons of record

Claims 176-181, 196-198 and 199 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Itskovitz-Eldor et al (Mol Med. 2000; 6(2):88-95, IDS) and Igelmund et al (Pflugers Arch. 1999 Apr;437(5):669-79) for the reasons of record.

Applicants' arguments with respect to art rejections have been considered but are not persuasive. The proposed amendments to claims 176 and 199 raise new issues that require further search and consideration and therefore have not been entered. To the extent applicants' amendments read on an in vitro culture of isolated human embryoid bodies comprising a plurality of non-cystic embryoid bodies each including human cells, it is noted that none of the references explicitly teach newly added limitation of EB comprising plurality of non cystic EB showing cardiac phenotype. The proposed amendments, if entered may obviate the basis of this rejection.

Claims 176-181, 196-199 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention for the reasons of record. Applicants' proposed amendment to claims correctly defining the culture recites new limitation that was not required by previously presented claims. This new limitation if entered may obviate the basis of this rejection.

Anoop Singh  
AU 1632